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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN TAN, PASCAL SERO, and KEVIN WALSH

Appeal 2009-010014
Application 09/873,061
Technology Center 2100

Before GREGORY J. GONSALVES, JEFFREY S. SMITH, and
JASON V. MORGAN, Administrative Patent Judges.

MORGAN, Administrative Patent Judge.

Opinion dissenting filed by SMITH, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

Introduction

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 54 – 58. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

54. A method for building a customized web site, wherein the method comprises performing a machine-executed operation involving instructions, wherein the machine-executed operation is at least one of:

- A) sending said instructions over transmission media;
- B) receiving said instructions over transmission media;
- C) storing said instructions onto a machine-readable storage medium; and
- D) executing the instructions;

wherein the instructions are instructions which, when executed by one or more processors, cause:

storing a web site XML [Extensible Markup Language] file;

wherein the web site XML file is an XML document that specifies the structure of a multi-page web site;

wherein the web site XML file specifies (a) relationships between web pages of the multi-page web site, and (b) the structure and content of the pages of the multi-page web site;

storing XML definitions for a plurality of components that are available for use by the customized web site;

presenting a user with a series of one or more user interfaces for modifying the multi-page web site to create the customized web site;

wherein the one or more user interfaces include controls for adding one or more components of said plurality of components to the multi-page web site;

receiving through the controls user input that adds a particular component of said plurality of components to said multi-page web site;

in response to the user input, adding the XML definition associated with the particular component to the web site XML file to produce a modified web site XML file that defines a multiple-page web site that includes said particular component; and

causing a web site building component to automatically build the customized web site based on the modified web site XML file.

(App. Br. 12 – 13, Claims App'x).

Rejections and Appellants' Contentions

Appellants contend that the Examiner erred in rejecting claims 54 – 58 under 35 U.S.C. § 102(e) as being anticipated by Underwood (US 7,152,207 B1).

ISSUE

Did the Examiner err in finding that Underwood discloses storing a web site XML file that specifies the structure of a multi-page web site and that specifies relationships between web pages of the multi-page web site?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments (Appeal Brief and Reply Brief) that the Examiner has erred. We agree with Appellants that the Examiner has erred.

The broadest reasonable construction of a "storing a web site XML file; wherein the web site XML file . . . specifies the structure of a multi-page web site; wherein the web site XML file specifies (a) relationships between web pages of the multi-page web site" requires storing the structure of a multi-page web site and relationships between web pages of the multi-page web site in a file encoded in Extensible Markup Language (i.e., XML). As the Application discloses, and as one of ordinary skill in the art would understand, XML is a markup language that is more flexible than (and distinct from) Hyper-Text Markup Language (HTML) (Spec. 5; Amendments to Spec. 3, May 6, 2004).

The Examiner's finds that "it is well known in the technological art that web content section(s)/page(s) or site(s) can be stored/expressed in HTML, XML and/or any suitable language which allows for website construction and connectivity" (Ans. 9 – 10) and that Underwood's Figures 18 – 19 show that a "site map shows relationships between pages shown on the left side column" (Ans. 10). However, these findings show merely that it would be possible to store a web site XML file that specifies the structure of a multi-page web site and that specifies relationships between web pages of the multi-page web site (where the XML file contains a site map). Anticipation requires that missing descriptive material is "necessarily present," not merely probably or possibly present in the prior art. See In re

Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). The Examiner's finding that Underwood "shows web contents can be structured/expressed in XML" (Ans. 10) is insufficient because Underwood does not specifically or inherently disclose storing in an XML file web contents specifying the structure of a multi-page web site and relationships between web pages of the multi-page web site. "An anticipatory reference must show all of the limitations of the claims arranged or combined in the same way as recited in the claims." *Vizio, Inc. v. Int'l Trade Com'n*, 605 F.3d 1330, 1342 (Fed. Cir. 2010).

Accordingly, we do not sustain the Examiner's anticipation rejection of claim 54, or of claims 55 – 58 which depends therefrom. The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. As such, we leave it to the Examiner to determine the appropriateness of any § 103 rejections based on Underwood.

CONCLUSIONS OF LAW

We conclude that the Examiner has not demonstrated that claims 54 – 58 are unpatentable because the Examiner erred in finding that Underwood discloses a web site XML file that specifies the structure of a multi-page web site and that specifies relationships between web pages of the multi-page web site.

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DECISION

We reverse the Examiner's decision rejecting claims 54 – 58.

REVERSED

ELD

Dissenting Opinion

SMITH, Administrative Patent Judge

I respectfully dissent from the majority's reversing the anticipation rejection of claims 54-58. Claim 54 does not recite any method step or structural limitation that is not described by Underwood. The only difference between claim 54 and the method described by Underwood is that claim 54 recites method steps performed with an XML file, such as "storing a web site XML file," and Underwood describes the identical method steps performed with an HTML file. The dispute before us therefore turns on the question: Does an XML file distinguish the method recited in claim 54 from the otherwise identical method described by Underwood? The majority answers "yes" to this question, but I respectfully disagree given the function performed by the XML file as recited in the claim.

The majority finds that the XML recited in claim 54 is a markup language that is more flexible than (and distinct from) Hyper-Text Markup Language (HTML). The majority cites page 5 of Appellants' Specification as support for this interpretation.

Of course, claims are not to be read in a vacuum, but must be given their broadest reasonable interpretation in light of the Specification as it would be interpreted by skilled artisans. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (citations omitted). But such an interpretation must not import limitations from the Specification into the claims. "[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.... [C]laims may embrace different subject

matter than is illustrated in the specific embodiments in the specification.”
Id. at 1323 (citations and internal quotation marks omitted).

In this case, the Specification, at best, merely states that XML is “more flexible” than HTML, without further explanation. See, e.g., Spec. 5:6-7. The Specification is silent as to what the additional flexibility may be. Moreover, the Specification is silent as to how any additional flexibility of XML affects the method recited in claim 54.

Nor do the claims clarify this uncertainty. Any flexible and distinct features of XML that distinguish XML from HTML are not reflected in the method steps of claim 54. Indeed, the method steps of claim 54 would be performed the same, regardless of whether the markup language file is XML or HTML.

The alleged novelty of claim 54 is that the method is performed with an XML file, as opposed to Underwood which performs the identical method with an HTML file. However, the extensible feature of the XML file does not alter any method steps recited in claim 54. The extensible feature of the XML file also does not alter any structural elements recited in claim 54. Therefore, the extensible feature of the XML file is non-functional descriptive material that does not distinguish the claim from the prior art in terms of patentability. See *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). See also *Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential).

Because each step recited in the method of claim 54 is described by Underwood, and each structural limitation of claim 54 is described by

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Underwood, I respectfully dissent from the majority's reversal of the Examiner's anticipation rejection of claims 54-58.